



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,755	07/31/2001	Toshihiro Kodaka	1095.1190	2798

21171 7590 11/23/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,755

Applicant(s)

KODAKA ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/31/2001.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 have been examined. Application 09/917,755 (Method of and apparatus for distributing advertisement) has a filing date 07/31/2001 and foreign priority 03/21/2001.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie (US 5,970,469).

As per claims 1, 12, 14 and 15, Scroggie teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a benefit upon purchase of a given commodity and advertisement information in association with said coupon information (see column 6, lines 5-12), and

transmitting said advertisement information to a terminal, which is connected via said network in response to a request from said terminal (see column 5, line 60 – column 6, line 15; column 10, lines 5-30);

storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see column 4, lines 34-50);

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to a benefit inquiry request for said given commodity from said terminal and indicating the determined benefit to said terminal (see column 9, line 55 – column 10, line 5).

As per claim 2, Scroggie teaches:

A method according to claim 1, wherein the benefit defined by said coupon information represent a discount to be offered upon purchase of the given commodity (see column 10, lines 29-32).

As per claim 3, Scroggie teaches:

A method according to claim 2, wherein said coupon information represents a discount amount to be offered upon purchase of the given commodity (see column 10, lines 29-32).

As per claim 4, Scroggie teaches:

A method according to claim 2, wherein said coupon information represents a discount rate to be offered upon purchase of the given commodity (see column 10, lines 20-40).

As per claim 5, Scroggie teaches:

A method according to claim 1, wherein said coupon information represents an expiry date and can be used only prior to said expiry date (see column 10, lines 20-30).

As per claim 6, Scroggie teaches:

A method according to claim 5, wherein said coupon information represents a period after which a user is able to use a coupon actually after the user has acquired the coupon (see column 10, lines 20-40).

As per claim 7, Scroggie teaches:

A method according to claim 1, further comprising the steps of:

referring to said coupon information stored in association with said terminal and determining a benefit upon purchase of the given commodity in response to an application for the purchase of the given commodity from said terminal (see column 11, line 40 – column 12, line 6); and

producing a sales contract for the given commodity with the determined benefit applied, and settling the purchase of the given commodity based on the sales contract (see column 11, line 40 – column 12, line 6).

As per claim 8, Scroggie teaches:

A method according to claim 7, wherein the purchase of the given commodity is settled by asking a banking organization server which can withdraw money from an account of the user of said terminal, to withdraw an amount of money based on the sales contract from the account of the user of said terminal (see column 12, lines 1-6; column 12, lines 60-63).

As per claim 9, Scroggie teaches:

A method according to claim 7, wherein said coupon information represents a condition in which said benefit is applicable, and the benefit defined by said coupon

information is applied to the sales contract only when said condition is satisfied upon the purchase of the given commodity (see column 12, lines 37-40).

As per claim 10, Scroggie teaches:

A method according to claim 9, wherein said coupon information defines a plurality of benefits which are applicable under different conditions, and one of the benefits which is most advantageous for the user is applied to the sales contract among those benefits whose conditions are satisfied upon the purchase of the given commodity (see column 12, lines 35-40).

As per claim 11, Scroggie teaches:

A method of distributing an advertisement with a computer over a network, comprising the steps of:

managing coupon information which defines a discount amount upon purchase of a given commodity and advertisement information in association with said coupon information, and transmitting said advertisement information to a terminal which is connected via said network in response to a request from said terminal (see column 4, lines 9-18);

storing said coupon information associated with said advertisement information transmitted to said terminal, in association with said terminal (see column 4, lines 33-50);

referring to said coupon information stored in association with said terminal and determining a price upon purchase of the given commodity in response to an application

Art Unit: 3622

for the purchase of the given commodity from said terminal (see column 12, lines 1-6);
and

producing a sales contract for the given commodity with the determined price applied, and settling the purchase of the given commodity based on the sales contract (see column 11, line 55 – column 12, line 6).

As per claim 13, Scroggie teaches:

A method of browsing through an advertisement distributed over a network, comprising the steps of: acquiring first contents to which advertisement information is related, via said network;

acquiring the advertisement information related to said first contents, from a coupon management server via said network (see column 4, lines 9-19);

storing an identifier transmitted from said coupon management server (see column 4, lines 33-50);

displaying said first contents and said advertisement information (see column 4, lines 9-19);

acquiring second contents including a list of commodities to which types of coupon information defining a benefit upon the purchase of commodities are related, via said network (see column 4, lines 50-67);

transmitting said types of coupon information related to the list of commodities included in said second contents and said identifier to said coupon management server to acquire usable coupon information from said coupon management server and

Art Unit: 3622

displaying said second contents and said usable coupon information (see column 4, lines 32-67).

Conclusion

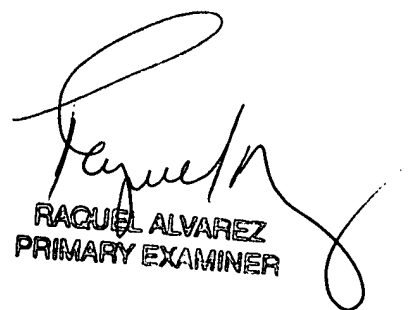
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
November 11, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER